REMARKS

Claims 1-58 are in the application.

Restriction Requirement

The Office Action has required restriction to one of the following inventions under 35 U.S.C. 121:

Group I: Claims 1-55 drawn to silicone compositions and methods for their use, classified in class 510, subclass 515+.

Group II: Claim 56 drawn to a method of designing a silicone, classified in class 106, subclass 1+.

Group III: Claim 57 drawn to a silicone, classified in class 106, subclass 1+.

Group IV: Claim 58 drawn to a silicone, classified in class 106, subclass 1+.

Having elected one of Group I-IV, the Office Action has required further restriction under 35 U.S.C. § 121 to elect a single disclosed species of silicone, even though this requirement is traversed.

In accordance with the restriction requirement, Applicants hereby elect Group II and the silicone species of Example 3 on page 22, with traverse. Applicants traverse the present restriction requirement based on the following remarks.

Paramount to issuing a restriction requirement, the Manual of Patent Examining Procedure ("MPEP") describes the criteria for restriction as follows:

(A) The inventions must be independent or distinct as claimed; and

(B) There must be a serious burden on the examiner if restriction is required.

MPEP § 803 (8th ed. 2003) (citations omitted). Furthermore, the MPEP requires that "Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the requirement in most cases." MPEP § 803 (8th ed. 2003). Indeed, an Examiner must clearly provide reasons and/or examples to support how the claims define inventions that are independent or distinct, and further to show how there is a serious burden on the Examiner.

The present Office Action alleges that Groups I-IV relate to inventions that are distinct from each other. The Office Action asserts that Groups I and III or IV are related as a combination or subcombintaion and further asserts that the combination as claimed does not require the particulars of the subcombination as claimed because the composition of Claim 1 need not meet the negative limitations of Claim 57 and S need not be 30. The

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Office Action asserts that the subcombinations have separate utility such as in fabric softening compositions. However, the Office Action does not provide or suggest any examples of the alleged separate utility of the subcombinations in fabric softening compositions as required by MPEP § 806.05(d). Applicants thus submit that the Office Action fails to set forth distinctness between Groups I and III or IV and thus restriction is improper.

The Office Action further alleges that Groups II and III are related as subcombinations disclosed as usable together in a single combination. The Office Action asserts that the subcombinations are distinct because Group II has separate utility such as in a fabric softener. However, the Office Action does not provide or suggest any examples of the alleged separate utility of Group II in a fabric softener as required by MPEP § 806.05(d). Applicants thus submit that the Office Action fails to set forth distinctness between Groups II and III and thus restriction is improper.

The Office Action asserts that Groups I and II are related as a product and a process of use. The Office Action alleges that the inventions are distinct because the product may be used in a laundry process without performing the recited calculations. Although the Office Action provides an example as to how the product can be used to practice another process, the Office Action does not recite any material differences as required by MPEP § 806.05(e). Applicants thus submit that the Office Action fails to set forth distinctness between Groups I and II and thus restriction is improper.

Even if the claims in an application contain inventions that are distinct, a proper restriction also requires that there be a serious burden on the Examiner. *See* MPEP § 803(B) (8th ed. 2003). As the MPEP explains:

> For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant.

MPEP § 803 (8th ed. 2003). Here, the Office Action does not provide the appropriate reasoning to support a *prima facie* case that a serious burden exists. Indeed, there is no discussion as to the extent of the burden on the Examiner to perform the search, except the Office Action alleges that Groups I-IV are classified differently. However, this allegation is not supported since the Office Action admits that Groups II-IV fall in the same classification. Since a serious burden on the Examiner has not been *prima facie* shown, the present restriction requirement is improper.

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As for the requirement to elect a single disclosed species of silicone, since the present claims are linking claims, if the elected species of silicone is found to be patentable, then Applicants submit that the non-elected species must be rejoined and the claims be examined in their entirety.

Based on the above remarks, reconsideration and withdrawal of the restriction requirment is respectfully requested. If, upon reconsideration, this restriction requirement is made final, Applicants respectfully request the next Office Action contain Form Paragraph 8.05 as suggested in MPEP § 821.01 (8th ed. 2003), to show that Applicants have traversed the requirement and have retained the right to petition from the requirement under 37 C.F.R. § 1.144.
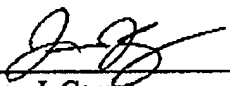
CONCLUSION

In view of the foregoing remarks, reconsideration of the application, withdrawal of the restriction requirement, and allowance of all claims are respectfully requested.

Respectfully submitted,

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